REMARKS

Claim 34 is amended. No new claims are added. Claims 1-70 are pending for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

Claim Rejections

35 U.S.C. § 103

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,932 to Paul in view of Applicant Admitted Prior Art (AAPA) and U.S. Patent No. 6,199,102 to Cobb.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Cobb, and U.S. Patent No. 5,459,717 to Mullan.

Claims 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Cobb, and U.S. Patent No. 6,072,942 to Stockwell.

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Cobb, and U.S. Patent No. 6,199,103 to Sakaguchi.

Claims 12-15, 24-27, 29, 30, 33-36, 38, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Stockwell, Paul, and Sakaguchi.

Claims 16, 23, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Stockwell, Sakaguchi, and Mullan.

Claims 17 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Stockwell, Sakaguchi and U.S. Patent No. 5,911,776 to Guck.

Claims 18, 28, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Stockwell, Sakaguchi and Paul.

Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaguchi in view of AAPA, Paul, and Stockwell.

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaguchi in view of AAPA, Paul, Stockwell, and Guck.

Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Paul, and Sakaguchi.

Claims 43-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Sakaguchi, Paul, and U.S. Patent No. 6,144,934 Stockwell.

Claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Paul, Sakaguchi, Stockwell '934, and Mullan.

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Paul, Sakaguchi, Stockwell '934 in further view of Stockwell '942.

Claim 48 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA.

Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Sakaguchi and Stockwell '942.

Claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA and Cobb.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Sakaguchi, and Mullan.

Claim 52 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA and Guck.

Claims 53-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Cobb.

Claim 58 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Cobb and Mullan.

Claims 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Cobb and Stockwell.

Claims 61-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Cobb and Sakaguchi.

Claims 64-67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Paul, Stockwell '942 and Sakaguchi.

Claim 68 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Paul, Stockwell '942, Sakaguchi, and Mullan.

Claim 69 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Paul, Stockwell '942, Sakaguchi, and Guck.

Claim 70 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Paul, Stockwell '942, Sakaguchi, and Paul.

The §103 Standard

In making out a §103 rejection, the Federal Circuit has stated that when one or more reference or source of prior art is required in establishing obviousness, "it is necessary to ascertain whether the prior art *teachings* would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitutions or other modification." *In re Fine,* 5 USPQ 2d, 1596, 1598 (Fed. Cir.

1988). That is, to make out a *prima facie* case of obviousness, the references must be examined to ascertain whether the combined *teachings* render the claimed subject matter obvious. *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).

Moreover, there is a requirement that there must be some reason, suggestion, or motivation *from the prior art*, as a whole, for the person of ordinary skill to have combined or modified the references. *See, In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Additionally, *particular findings* must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *See, e.g., In Re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art *teaches away* from the claimed combination. A reference is said to teach away when a person or ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).

In order for a *prima facie* case of obviousness to be made, the resulting combination or motivation must appear to show or suggest the claimed invention. *In re Nielson*, 2 USPQ 2d1525, 1528 (Fed. Cir. 1987).

In view of the standard for establishing a *prima facie* case of obviousness, Applicant respectfully disagrees with the Office's rejections of the present claims and submits that the Office has not established a *prima facie* case of obviousness.

The Primary References to Paul, Cobb and Sakaguchi

The reference to **Paul** discloses a system for eliminating unsolicited electronic mail that generates and stores a user inclusion list including identification data for identifying e-mail desired by the user. An e-mail filter filters incoming mail received in the user's e-mail store based upon three fields of data contained in the incoming e-mail, the "FROM" field, the "TO" field and the "SUBJECT" field. Filtering may also include the "CC" and "BCC" fields to filter e-mail messages on which the user is listed as a CC or BCC recipient rather than a direct recipient.

Data from one or more fields of incoming electronic mail messages are compared with the identification data stored in the user inclusion list. If the electronic mail message data matches corresponding identification data from the user inclusion list, the e-mail message is marked with a first display code, such as "OK." If no match is detected, the system performs at least one heuristic process to determine whether the electronic mail message may be of interest to the user. If the message satisfies one or more criteria as determined by the heuristic process and is therefore of potential interest to the user, the message is marked with a second display code, such as "NEW." If the e-mail message does not satisfy any of the heuristic criteria, the e-mail message may be marked with a third display code, such as "JUNK." The processed e-mail messages are displayed to the user

in a display mode corresponding to the display codes respectively assigned to the messages.

The **Cobb** reference discloses a system and method for filtering unsolicited electronic commercial messages. The disclosed system screens out unsolicited commercial messages by receiving the message from a sender, sending a challenge back to the sender, receiving a response to the challenge, and determining if the response is a proper response.

The **Sakaguchi** reference discloses a system that can generate determination conditions and determine whether email is junk email based on one determination condition. The system comprises a junk electronic mail determination processing section for determining whether or not a given electronic mail piece, through an input section, is junk based on the determination condition stored in a junk electronic mail determination condition storage section. An estimated junk electronic mail storage section stores the electronic mail piece if the electronic mail piece is determined to be junk. A junk electronic mail exemplification learning section analyzes content information of the electronic mail piece stored in the storage section and extracts a feature amount to determine that electronic mail is junk, and adds the extracted feature amount to the junk electronic mail determination condition storage section as a junk electronic mail determination condition. A keyword vector is used as the determination condition.

The Secondary References

The secondary references used in the Office's combination, and which are not discussed above, are the references to Stockwell (Patent Nos. 6,072,942 and 6,144,934), Mullan, and Guck.

The reference to **Stockwell (the '942 patent)** discloses a system and method for filtering electronic mail messages. A message is received and processed through one or more filter flows. Each filter flow is comprised of one or more self-contained nodes which can be combined in whatever order is required to enforce a given security policy. Node independence provides a policy-neutral environment for constructing filter flows. A filter flow may be as simple as forwarding the mail to the intended recipient, or may perform one or more checks where it decides whether to forward, reject, return (or some combination thereof) the message. Certain node types are also able to append information on to a mail message, while others are able to modify certain parts of a mail message. Several of the node types are able to generate audit or log messages in concert with processing a mail message.

The reference to **Stockwell (the '934 patent)** discloses an electronic message filtering system and method in which a message is received as input to a filter and decomposed into a set of components. The set of components is then processed through a pattern matching algorithm to determine if the message contents contain patterns inherent in a specified pattern, such as a natural language. The results of the pattern match analysis are output by the filter.

The reference to **Mullan** discloses a method and apparatus for routing a message embodied in a signal received by an electronic messaging system. The method includes formatting a search key using address codes parsed from a user address specified in the message, where each of the address codes corresponds to a different level of specificity for the user address. An attempt is made to retrieve a record from a database of routing information using the search key. If no record is found, the address code corresponding to the most detailed level of specificity in

the user address is stripped from the search key and another attempt is made to retrieve a record. This process continues until a record is successfully retrieved from the database or a predetermined base level of specificity is reached.

The reference to **Guck** discloses a network providing a server using an object-database that enables an author to create and store an original document, as a source file with a first format. Software in the data base provides multiple sets of shadow file-converter groups connected to the source file of the original document. Each shadow file-converter set enables the transformation of the original source file format into a particular other specific type of format. A client or user of the network can access and receive a copy of the original source document which is automatically reformatted to match the requirements of the receiver's appliance. Thus, one original source document can be created and then published in any specific format to multiple numbers of and types of receiving appliances.

Claims 1-11

Claim 1 recites an email filtering method comprising [emphasis added]:

- defining at least one heuristic that determines whether an incoming email message likely constitutes unsolicited commercial email by considering an established pattern that such unsolicited commercial email typically exhibits when it is sent;
- applying said at least one heuristic to at least one email message that is received by a web server that comprises part of a web-based email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages; and
- redirecting said at least one email message if application of said at least one heuristic indicates that said at least one email message likely constitutes unsolicited commercial email,

- wherein said redirecting comprises *placing a copy of the email message at a location not dedicated to storage of just one particular user's email.*

In making out the rejection of this claim, the Office argues that Paul discloses placing a copy of the email message at a location not dedicated to storage of just one particular user's email. Applicant respectfully but strongly disagrees and traverses the Office's rejection.

In support of its position, the Office cites to column 7, lines 15-25, 36-50, and column 7, lines 63 through column 8, line 4, all of which is reproduced below:

> The operation of the components of the e-mail server 301 shown in FIG. 3 is similar to the corresponding components in the user terminal system of FIG. 1. All e-mail received by server 301 is stored in e-mail store 306. The e-mail filter 304 filters the stored e-mail messages in accordance with the information stored in the inclusion list processor 302. E-mail addressed to each user A, B, C, and D is separately filtered using the inclusion list stored in inclusion list processor 302 for each user respectively. Once the e-mail stored in store 306 is processed by e-mail filter 304, *the filtered e-mail is then forwarded to each user's* terminal.

> . . . If no match is detected, the e-mail filter 304 performs at least one type of heuristic processing to determine whether the e-mail may be of interest to the user, and, if not, *labels the e-mail message accordingly, for example, as "JUNK."*

> In the preferred server embodiment shown in FIG. 3, the e-mail filter 304 interacts with the e-mail message store 306 that processes the e-mail and performs other known functions for a multiplicity of e-mail addresses or accounts. In the preferred embodiment, the e-mail store 306 is an improved e-mail server message store that stores additional information about the category of each e-mail message. In an alternative preferred embodiment, the status of e-mail messages is handled in a separate database (not shown) outside the message store 306.

. . . FIG. 3A illustrates an alternative preferred embodiment in which the e-mail filter receives and filters incoming e-mail messages *before they are stored in e-mail store 306*. This embodiment may be implemented using a known message communications means, such as MAPI or an Internet mail protocol such as POP3, IMAP or SMTP. This embodiment has the advantage of reducing the data traffic flow on a communications link by filtering out unsolicited e-mail before it is stored at the user site.

As the excerpt demonstrates, Paul discloses marking e-mail that does not satisfy any of the heuristic criteria with a display code, such as "JUNK", and then forwarding the e-mail to *each user's* terminal. The Office recognizes this when it cites to the *exact same excerpt* of Paul on page 34 of the Office Action and states, in relation to claim 43, "Paul teaches email messages saved to dedicated user storage locations."

Paul also discloses an embodiment wherein incoming e-mail messages are filtered before they are stored. Presumably, in this embodiment, the e-mail messages that do not satisfy any of the heuristic criteria are deleted and therefore inaccessible to the recipients. Nowhere does Paul disclose or suggest a method of redirecting at least one email message wherein redirecting comprises *placing a copy of the email message at a location not dedicated to storage of just one particular user's email*. In fact, Paul *teaches directly away* from Applicant's claimed redirection feature. Moreover, Cobb does not supply the missing feature. Cobb discloses redirection of email; but given the failure of Paul to teach what the Office argues it does, Cobb adds nothing of significance.

Accordingly, the Office has not established a *prima facie* case of obviousness, and this claim is allowable.

Claims 2-11 depend either directly or indirectly from claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

For example, **claim 2** depends from claim 1 recites the act of redirecting comprises placing a copy of the email message at a *single location from which it can be accessed by more than one intended recipient* of the email message. The Office argues that Cobb teaches this additional feature and cites to column 3, lines 36-38, in support of its position. That excerpt is reproduced below:

> The *user terminal* software system of Fig. 1 further includes an e-mail storage database 106 that receives and stores incoming e-mail and stores records of outgoing e-mail.

In this excerpt, Cobb refers to a location accessible by *only* the intended recipient. As such, Cobb *teaches directly away* from Applicant's claimed feature. For at least this reason, claim 2 is allowable.

Claim 10 provides another illustrative example. Claim 10 recites that the act of redirecting comprises redirecting at least one email message to a location that can be *shared by a plurality of intended recipients*. This claim further recites notifying intended recipients of the email message that an email message intended for them has been redirected to the location. The Office argues that Sakaguchi discloses redirecting at least one email message to a location that can be shared by a plurality of intended recipients. The Office cites to column 8, lines 31-34, which is reproduced below:

... a method of sorting electronic mail into estimated junk electronic mail and estimated non-junk electronic mail and adding them to their respective storage units (not shown) ...

There is nothing in this excerpt, or anywhere else in Sakaguchi to indicate that email is redirected to a location that can be *shared by a plurality of intended recipients*. For at least this reason, claim 10 is allowable.

In addition, with respect to those claims that are rejected in further view of Mullan and Stockwell '942 those references are not seen to add anything of significance given the Office's failure to establish a *prima facie* case of obviousness with respect to claim 1.

Claims 12-18

Claim 12 recites an email filtering method comprising [emphasis added]:

- receiving an email message at an email server that maintains inboxes for individual recipients, wherein the email message is addressed to a plurality of recipients, the email server comprising part of an Internet-based email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages;
- calculating a score for the email message at the server location based upon at least one of (a) the size of the email message, and (b) the number of specified recipient addresses;
- comparing the score with a threshold value that defines a likelihood of whether an email message constitutes an unwanted email message;
- responsive to the email message exceeding the threshold value, *placing a copy of the email message at a first location other than an individual storage location dedicated to an individual intended recipient of the email message*; and
- sending a notification to the intended recipients that a copy of an email message that was intended for them has been placed at the first location.

In making out the rejection of this claim, the Office argues that the combination of Cobb, Stockwell, and Sakaguchi teach the recited subject matter except for placing a copy of the email message at a first location other than an individual storage location dedicated to an individual intended recipient of the email message. The Office then argues that Paul teaches the missing feature and cites to the same excerpt that was reproduced above.

Applicant respectfully traverses the Office's rejection. Paul in no way teaches or suggests placing a copy of the email message at a first location *other than an individual storage location dedicated to an individual intended recipient of the email message*. Rather, Paul *teaches directly away* from Applicant's claimed subject matter by marking e-mail with one of several display codes and then forwarding it to *each user's* terminal, an individual storage location *dedicated* to an individual intended recipient of the e-mail message. Accordingly, for at least this reason, this claim is allowable.

Claims 13-18 depend from claim 12 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 12, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

In addition, with respect to those claims that are rejected in further view of Mullan and Guck, those references are not seen to add anything of significance given the allowability of this claim.

Claims 19-23

Claim 19 recites a computer program stored on one or more computer readable media for processing email and comprising the following steps:

- receiving an email message at a server location, the email message being addressed to a plurality of recipients, the server location comprising one or more servers that comprise part of an Internet-based email system in which, for at least some users of the system, a client user interface email environment is generated by the system through use of HTML or web pages that are sent via the Internet to client devices and used by a browser executing on a client device to render the user interface email environment;
- placing only one copy of the email message *at a first storage location that is not a dedicated storage location for just one of the intended recipients*; and
- notifying each of the intended recipients that an email message intended for them has been placed at the first location.

In making out the rejection of this claim, the Office argues that combination of Sakaguchi and Stockwell '942 teach the recited subject matter except for placing only one copy of the email message at a first location that is not a dedicated storage location for just one of the intended recipients. Again, the Office argues that Paul teaches the missing feature and cites to the same excerpt that was reproduced in the discussion of claim 1.

Again, Applicant respectfully traverses the Office's rejection. There is no indication that Paul, or any other reference cited by the Office, places *only one copy* of an email message at a first storage location that is *not a dedicated storage location for just one of the intended recipients*. Rather, Paul discloses a method in which e-mail is marked with various display codes and then forwarded on to

each user's terminal. Therefore, Paul appears to forward each e-mail to multiple locations that are *dedicated* storage locations for each of the intended recipients. As such, Paul *teaches directly away* from Applicant's claimed subject matter. Accordingly, for at least this reason, this claim is allowable.

Claims 20-23 depend from claim 19 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 19, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

For example, **claim 22** recites that the act of notifying comprises creating a pointer to the first location, and placing the pointer at a plurality of second locations *each of which being dedicated to a different one of the intended recipients,* wherein individual recipients can use the pointer to access the email message at the first storage location. The Office appears to argue that Sakaguchi teaches Applicant's notification feature and cites to column 8, lines 22-26 in support thereof. This excerpt is provided below:

> Further, in the embodiment, the determination result of the junk electronic mail determination processing section 2 is also fed into a determination result notification section 12, which enables the user to specify a notification method to the receiving person separately for estimated junk electronic mail and estimated non-junk electronic mail as he or she desires.

There is nothing in this excerpt, or anywhere else in Sakaguchi, to suggest creating a pointer to the first location, and placing the pointer at a plurality of second locations *each of which being dedicated to a different one of the intended recipients,* wherein individual recipients can use the

pointer to access the email message at the first storage location. Instead, Sakaguchi simply discloses storing estimated junk electronic mail and estimated non-junk electronic mail, both directed to a *single recipient*, in different storage units. Moreover, Applicant's notification feature is not taught or suggested by either Paul, Stockwell '942, or Guck. For at least these reasons, claim 22 is allowable. In addition, with respect to those claims that are rejected in further view of Cobb, Mullan and Guck, those references are not seen to add anything of significance given the allowability of claim 19.

Claims 24-33

Claim 24 recites a programmed email server that contains computer-readable instructions which, when executed by the email server, perform the following steps:

- determining whether an email message that is received by the email server likely constitutes an unwanted email message, the email server comprising part of a web-based email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages that are sent to client devices; and
- if the email message likely constitutes an unwanted email message:
- storing a copy of the email message at a first storage location *rather than individual storage locations that are dedicated to individual intended recipients of the email message*; and
- notifying intended recipients of the email message that an email message addressed to them has been received by the server.

In making out the rejection of this claim, the Office argues that combination of Cobb, Stockwell '942, and Sakaguchi teach the recited subject matter except for storing a copy of the email message at a first location rather than individual storage locations that are dedicated to individual intended recipients of the email message. Again, the Office argues that Paul teaches the missing feature and cites to the same excerpt that was reproduced in the discussion of claim 1.

Applicant respectfully traverses the Office's rejection. There is no indication that Paul, or any other reference cited by the Office, stores a copy of the email message at a first storage location *rather than individual storage locations that are dedicated to individual intended recipients of the email message.* Rather, Paul discloses a method in which e-mail in marked with various display codes and then forwarded on to *each user's* terminal. Therefore, Paul appears to forward each e-mail to multiple locations that are *dedicated* storage locations for each of the intended recipients. As such, Paul *teaches directly away* from Applicant's claimed subject matter. Accordingly, for at least this reason, this claim is allowable.

Claims 25-33 depend from claim 24 either directly or indirectly and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 24, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

For example, **claim 26** further recites enabling intended recipients, if they so desire, to read the email message at the *first* storage location. The Office, citing column 1, lines 21-23, argues that Sakaguchi teaches this feature. That excerpt from Sakaguchi is reproduced below:

Then, to efficiently handle received electronic mail, the receiving person needs to handle electronic mail in response to the electronic mail contents in a different manner such that unnecessary electronic mail is deleted as it is received or that if the receiving person reads the electronic mail, he or she does this when he or she has some free time.

Claim 24, from which claim 26 depends, defines Applicant's first storage location as something *other* than individual storage locations that are dedicated to individual intended recipients of the email message. Applicant respectfully submits that there is nothing in the cited Sakaguchi excerpt which even *hints* at the ability of an intended recipient to read an email message at anything other than an individual storage location that is dedicated to that particular intended recipient. For at least this reason, claim 26 is allowable.

In addition, with respect to those claims that are rejected in further view of Mullan, that reference is not seen to add anything of significance given the allowability of claim 24.

Claims 34-39

As amended, **Claim 34** recites an email screening method comprising [emphasis added]:

- developing a profile of unsolicited commercial email based upon the size of an email message and the number of specified recipient addresses of the email message;
- configuring a mail server that is responsible for storing and distributing email messages to a plurality of clients with a filter processor that is programmed to evaluate email messages that are received in light of the developed profile, the mail server comprising part of a web-based email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages that are sent to client devices;

- evaluating email messages with the filter processor and determining whether the email messages fit the developed profile; and
- if an email message fits the developed profile, initiating a remedial measure that ensures that the mail server *does not make as many copies of the email message as there are specified recipient addresses, yet still allows the email message to be accessible to at least one recipient.*

This claim has been amended to clarify that the act of initiating a remedial measure comprises ensuring that the mail server does not make as many copies of the email message as there are specified recipient addresses, *yet still allows the email message to be accessible to at least one recipient.* Support for this feature is provided in the Abstract, particularly lines 13-15.

In making out the rejection of this claim, the Office argues that the combination of Cobb and Stockwell discloses an email screening method as recited but does not disclose Applicant's remedial measure feature. The Office then relies on Paul for this feature.

In view of the amendment of this claim which clarifies that the remedial measure ensures that the mail server *still allows the email message to be accessible to at least one recipient*, Applicant respectfully traverses the Office's rejection. None of the references cited by the Office disclose or suggest an email screening method in which a remedial measure is initiated that ensures that the mail server *does not make as many copies of the email message as there are specified recipient addresses, yet still allows the email message to be accessible to at least one recipient.* Rather, Paul's remedial measure appears to delete the e-

mail messages that do not satisfy any of the heuristic criteria so that they are *inaccessible* to any of the recipients. As such, Paul *teaches directly away* from Applicant's remedial measure feature. Accordingly, for at least this reason, this claim is allowable.

Claims 35-39 depend either directly or indirectly from claim 34 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 34, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

For example, **claim 35** recites that the remedial measure comprises storing one copy of the email message at a server storage location, *instead of storing multiple copies of the email message for the specified recipient addresses*. The Office argues that Cobb teaches this feature and cites to column 3, lines 36-38 in support. That excerpt is provided below:

> For this reason, most filter designs take a different approach and move suspected junk messages to a temporary or miscellaneous holding category for review by the *recipient* before deletion.

This excerpt does not teach a remedial measure which stores one copy of the email message at a server storage location, *instead of storing multiple copies of the email message for the specified recipient addresses*. Here, Cobb simply discusses moving email messages to a special holding category for review by a *single recipient*. There is nothing to indicate that this is in *any* way a remedial

measure that stores *one copy* of the email as opposed to storing multiple copies for the multiple recipients. For at least this reason, claim 35 is allowable.

Likewise, **claim 36** recites that the remedial measure comprises storing *one copy* of the email message at a server storage location, *instead of storing multiple copies* of the email message for the specified recipient addresses, and *notifying intended recipients* that an email message intended for them has been stored at the server storage location. In rejecting this claim, the Office argues that Sakaguchi's column 8, lines 31-34, teaches storing one copy of the email message at a server storage location, instead of storing multiple copies of the email message for the specified recipient addresses. This excerpt is reproduced below:

> . . . a method of sorting electronic mail into estimated junk electronic mail and estimated non-junk electronic mail and adding them to their respective storage units (not shown) . . .

The Applicant respectfully maintains that this teaching falls *far short* of the mark. There is no indication that Sakaguchi even *contemplates* a method in which only *one copy* of the email message is stored at a server storage location, *instead of multiple copies* of the email message being stored for the specified recipient addresses.

The Office also argues that Sakaguchi, in column 8, lines 22-26, teaches notifying intended recipients that an email message intended for them has been stored at the server location. The excerpt is as follows:

> Further, in the embodiment, the determination result of the junk electronic mail determination processing section 2 is also fed into a determination result notification section 12, which enables the user to specify a notification method to the receiving person separately for estimated junk electronic mail and estimated non-junk electronic mail as he or she desires.

While Sakaguchi does provide for *some* type of notification, it does not provide for notifying intended recipients that an email message intended for them has been stored at the server location, where *only one copy* of the email message is stored at a server storage location, *instead of multiple copies* of the email message being stored for the specified recipient addresses

For at least these reasons, claim 36 is allowable.

In addition, with respect to those claims that are rejected in further view of Guck, that reference is not seen to add anything of significance given the allowability of claim 34.

Claims 40-41

Claim 40 recites an email delivery method comprising [emphasis added]:

- establishing a bulk email folder in which bulk email is to be stored;
- configuring an email server to receive email messages and deliver them *either* to multiple server storage locations that are dedicated to storing email messages for respective recipients *or to a single, shared location that can be shared by a plurality of the recipients*, the email server comprising part of an email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages that are sent to client devices;
- receiving an email message;
- comparing an address for the sender of the email message with a recipient's list of approved senders; and
- *delivering the email message to the single, shared location* if: (a) the email message is not directly addressed to a recipient that is serviced by the server, and (b) the sender's address does not appear in the recipient's list of approved senders.

In making out the rejection of this claim, the Office argues that the combination of Cobb, Stockwell '942, and Sakaguchi discloses an email delivery method as recited but does not disclose configuring an email server to receive email messages and deliver them *either* to multiple server storage locations that are dedicated to storing email messages for respective recipients *or to a single, shared location that can be shared by a plurality of the recipients*. The Office again looks to Paul for the missing features.

Applicant respectfully traverses the Office's rejection. There is no indication that Paul, or any other reference cited by the Office, teaches or suggests an email server configured to receive email messages and deliver them *either* to multiple server storage locations that are dedicated to storing email messages for respective recipients *or to a single, shared location that can be shared by a plurality of the recipients.* Rather, Paul discloses an email server configured to receive email messages, mark them with a display code, and deliver them to *each user's* terminal. Therefore, Paul's email server is configured to deliver email messages *only* to multiple storage locations that are dedicated to storing email messages for respective recipients. As such, Paul teaches *directly away* from Applicant's claimed delivery feature, which also allows messages to be delivered to a single, shared location. Accordingly, for at least these reasons, this claim is allowable.

Claim 41 depends from claim 40 and is allowable as depending from an allowable base claim. This claim is also allowable for its own recited features

which, in combination with those recited in claim 40, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

Claim 42

Claim 42 recites an email screening method comprising [emphasis added]:

- developing a profile of unwanted email messages based upon whether an email message is similar in content to another email message;
- configuring a mail server that is responsible for storing email messages for a plurality of clients with a filter processor that is programmed to evaluate email messages that are received in light of the developed profile, the mail server comprising part of an email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages that are sent to client devices;
- evaluating email messages with the filter processor and determining whether the email message fits the developed profile; and
- if the email message fits the developed profile, *placing a copy of the email message in a first location and, rather than placing multiple copies of the email message in multiple dedicated client storage locations, notifying the multiple clients that an email message addressed to them has been received* so that the clients can read the email message if they so desire.

In making out the rejection of this claim, the Office argues that the combination of Cobb and Sakaguchi discloses an email screening method as recited but does not disclose, if the email message fits the developed profile, *placing a copy of the email message in a first location and, rather than placing multiple copies of the email message in multiple dedicated client storage locations, notifying the multiple clients that an email message addressed to them*

has been received. The Office again cites to column 7, lines 15-25, 36-50, and column 7, lines 63 through column 8, line 4, of Paul for the missing features. That except was set forth previously.

Applicant respectfully traverses the Office's rejection. There is no indication that Paul, or any other reference cited by the Office, teaches or suggests that, if the email message fits the developed profile, placing a copy of the email message in a first location and, *rather than placing multiple copies of the email message in multiple dedicated client storage locations*, notifying the multiple clients that an email message addressed to them has been received. As discussed previously, Paul appears to teach placing *multiple copies* of an email message in *multiple dedicated storage locations* or, in another embodiment, deleting the email message *without notifying* the recipients that an email message addressed to them has been received. Therefore, Paul *teaches directly away* from Applicant's claimed delivery feature. Accordingly, for at least this reason, this claim is allowable.

Claims 43-47

Claim 43 recites an email screening method comprising [emphasis added]:

- defining an index having values that are assigned to various degrees of desirability that an email message can have, wherein the degrees of desirability extend from a low degree of desirability to a high degree of desirability;
- associating a plurality of parameters having parameter values with the various degrees of desirability, wherein at least some of

the parameters do not depend on any message that is conveyed by any content of an email message; and

- establishing a *user interface* through which a *user can adjust either (a) individual parameter values* that, in turn, establish a degree of desirability, *or (b) index values* that themselves establish a degree of desirability that email messages must have in order to be saved to dedicated user storage locations; and

- evaluating, using a computing device comprising part of an email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages that are sent to client devices, incoming email messages against the index value that is defined by the user.

In rejecting this claim, the Office cites column 6, lines 28-29, of Sakaguchi and argues that it teaches establishing a user interface through which a user can adjust individual parameter values that, in turn, establish a degree of desirability. This excerpt is reproduced below:

> The user can also see the data stored in the estimated junk electronic mail storage section 6 . . .

Applicant respectfully submits that Sakaguchi does not teach or suggest Applicant's claimed features. The excerpt states that a user can see electronic mail that is estimated junk mail. Later in column 6, Sakaguchi states that a user can specify the electronic mail to be learnt in exemplification through the input section 1. Sakaguchi's system then automatically generates and stores a junk electronic mail determination condition. The junk electronic mail determination condition is then used to determine whether or not received electronic mail is junk. Applicant cannot find *anything* in Sakaguchi that teaches or suggests establishing a *user*

interface through which a *user can adjust either (a) individual parameter values* that, in turn, establish a degree of desirability, *or (b) index values* that themselves establish a degree of desirability that email messages must have in order to be saved to dedicated user storage locations. Rather, Sakaguchi's user simply supplies an *example* of junk mail to the system which then *automatically generates* a junk electronic mail determination condition. In such a system, the user is not adjusting either individual parameter values *or* index values, as Applicant uses those terms.

In addition, the Office cites column 17, lines 40-41, of Cobb and argues that Cobb teaches establishing a user interface through which a user can adjust index values. This excerpt is provided below:

> Various heuristics can be applied to an email address to determine if
> it is valid . . .

This excerpt also does not disclose Applicant's claimed features. Applicant can find nothing in Cobb which teaches or suggests establishing a user interface through which a *user can adjust either (a) individual parameter values* that, in turn, establish a degree of desirability, *or (b) index values* that themselves establish a degree of desirability that email messages must have in order to be saved to dedicated user storage locations. Neither can Applicant find this teaching in Stockwell' 942. For at least these reasons, this claim is allowable.

Claims 44-47 depend from claim 43 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited

features which, in combination with those recited in claim 43, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

In addition, with respect to those claims that are rejected in further view of Stockwell '942, that reference is not seen to add anything of significance given the allowability of this claim.

Claims 48-52

Claim 48 recites an email server system comprising [emphasis added]:

- a user storage database configured to store user information including email messages that are intended for individual users; and
- a server configured to receive email messages that are intended for various users and store the email messages in dedicated user storage locations within the user storage database;
- wherein the server is further configured to screen email messages based upon a set of heuristics that determine whether an email message likely constitutes an unwanted email message, the server further being configured to *place a single copy of an email message in a storage location that is not a dedicated user storage location* if it is determined by screening the email message that it likely constitutes an unwanted email message, said system comprising an Internet-based system that is configured to send email messages to users in a format in which a user's browser application processes the email messages and provides a user interface for a user to view the email messages.

In making out the rejection of this claim, the Office argues that Paul discloses placing a single copy of an email message in a storage location that is not a dedicated user storage location if it is determined by screening the email message that it likely constitutes an unwanted email message. The Office cites to

the same portions of Paul as it has done in the rejection of every other independent claim. That excerpt was set forth previously in the discussion of claim 1.

Applicant respectfully traverses the Office's rejection. There is no indication that Paul, or any other reference cited by the Office, teaches or suggests placing a *single copy* of an email message in a storage location that is *not a dedicated user storage location* if it is determined by screening the email message that it likely constitutes an unwanted email message. Rather, Paul discloses a method in which e-mail is marked with various display codes and then forwarded on to *each user's* terminal. Therefore, Paul appears to forward each e-mail to multiple locations that *are* dedicated user storage locations. As such, Paul *teaches directly away* from Applicant's claimed subject matter. Accordingly, for at least this reason, this claim is allowable.

Claims 49-52 depend from claim 48 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 48, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

Claim 51 serves as a good example. Claim 51 recites that the set of heuristics *considers the number* of invalid specified user addresses that are specified by an email message. The Office cites to column 10, lines 37-38, of Mullan in its rejection of this claim. That excerpt refers to Mullan's claim 5, which

is dependent on claim 2, which in turn is dependent on claim 1. All three claims are set forth below for the Office's convenience:

1. *A method for routing a message* encoded in a signal received by an electronic messaging system, the electronic messaging system including a data store of routing information, the message containing a user address having a plurality of address codes, the method comprising:

(a) setting a search level indicator according to a number of address codes in the user address;

(b) attempting to retrieve routing information associated with the plurality of address codes in the user address;

(c) eliminating one of the plurality of address codes from the user address if no routing information is retrieved;

(d) repeating steps (a) through (c) until routing information is successfully retrieved or the search level indicator equals a predetermined base level; and

(e) in the event routing information is successfully retrieved, routing the message according to said routing information.

2. The method of claim 1 wherein the one of the plurality of address codes eliminated from the user address corresponds to a most specific level of address information contained in the user address.

5. The method of claim 2 further comprising the step of *indicating* an invalid user address if no routing information is retrieved within the predetermined number of attempts.

As is clear from Mullan's claims, Mullan discloses a method for *routing* a message. Mullan's claim 5, which the Office specifically cites, deals with *indicating* an invalid user address in the process of trying to route the message. On the other hand, Applicant's claim 51 discloses a server configured to *screen* email messages based upon a set of heuristics that determine whether an email message

likely constitutes an unwanted email message. The set of heuristics *considers the number* of invalid specified user addresses that are specified by an email message. A server, configured to screen email messages by use of a heuristic which considers the number of invalid specified user addresses is quite different than a method of routing messages which merely *indicates* an invalid user address. For at least this reason, claim 51 is allowable.

In addition, with respect to those claims that are rejected in further view of Stockwell '942 and Cobb, those references are not seen to add anything of significance given the allowability of claim 48.

Claims 53-57

Claim 53 recites an email filtering method comprising [emphasis added]:

- defining at least one heuristic that determines whether an incoming email message likely constitutes unsolicited commercial email by considering an established pattern that such unsolicited commercial email typically exhibits when it is sent;
- applying said at least one heuristic to at least one email message; and
- redirecting said at least one email message if application of said at least one heuristic indicates that said at least one email message likely constitutes unsolicited commercial email, wherein said redirecting comprises *placing a copy of the email message at a location not dedicated to storage of just one particular user's email*.

In making out the rejection of this claim, the Office argues that Paul discloses placing a copy of an email message at a location not dedicated to storage of just one particular user's email. Again, the Office cites to the same portions of Paul to support its argument.

Applicant respectfully traverses the Office's rejection. There is no indication that Paul, or any other reference cited by the Office, teaches or suggests placing a copy of an email message at a location *not dedicated to storage of just one particular user's email*. As discussed previously, Paul *teaches directly away* from Applicant's claimed redirection feature by marking e-mail with various display codes and then forwarding them on to multiple locations that *are* dedicated to storage of just one particular user's email. Accordingly, for at least this reason, this claim is allowable.

Claims 54-63 depend from claim 53 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 53, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

Claim 54 serves as an illustrative example. Claim 54 recites that the act of redirecting comprises placing a copy of the email message at a *single location from which it can be accessed by more than one intended recipient* of the email message. In rejecting this claim, the Office cites to Cobb, column 3, lines 36-38, which is reproduced below:

> The *user terminal* software system of Fig. 1 further includes an e-mail storage database 106 that receives and stores incoming e-mail and stores records of outgoing e-mail.

In this excerpt, Cobb refers to a location accessible by *only* the intended recipient. As such, Cobb *teaches directly away* from Applicant's claimed feature. For at least this reason, claim 54 is allowable.

Another example is **claim 58**. Claim 58 recites that the *pattern is associated with the number of invalid specified recipient addresses*. The Office cites to column 10, lines 37-38, of Mullan in its rejection of this claim. That excerpt refers to Mullan's claim 5, which is dependent on claim 2, which in turn is dependent on claim 1. All three claims were set forth above in the discussion of claim 51 and are not repeated here.

As is clear from Mullan's claims, Mullan discloses a method for *routing* a message. Mullan's claim 5, which the Office specifically cites, deals with *indicating* an invalid user address in the process of trying to route the message. On the other hand, Applicant's claim 58 recites an email filtering method which defines at least one heuristic that determines whether an incoming email message likely constitutes unsolicited commercial email by considering an established pattern that such unsolicited commercial email typically exhibits when it is sent. This pattern is associated with the *number* of invalid specified recipient addresses. This email filtering method is very different from a method which simply *indicates* an invalid user address in the process of trying to *route* a message. For at least this reason, claim 58 is allowable.

Yet another example is **claim 62**. Claim 62 recites that the act of redirecting comprises redirecting at least one email message to a location that can be *shared by a plurality of intended recipients* for reading said email message. This claim further recites notifying intended recipients of the email message that an email message intended for them has been redirected to the location. The Office cites column 8, lines 31-34, of Sakaguchi in rejecting this claim. Sakaguichi's excerpt is set forth below:

> . . . a method of sorting electronic mail into estimated junk electronic mail and estimated non-junk electronic mail and adding them to their respective storage units (not shown) . . .

There is nothing in this excerpt, or anywhere else in Sakaguchi to indicate that email is redirected to a location that can be *shared by a plurality of intended recipients*. For at least this reason, claim 62 is allowable.

Moreover, **claim 63** recites that the act of redirecting comprises storing *only one copy* of the email message. The Office turns to Sakaguchi for this teaching, specifically column 2, lines 3-4, and column 8, lines 31-34. These excerpts are reproduced below:

> . . . if the electronic mail piece is determined junk, storing it in an estimated junk electronic mail storage section . . .

> . . . a method of sorting electronic mail into estimated junk electronic mail and estimated non-junk electronic mail and adding them to their respective storage units (not shown) . . .

The Applicant respectfully submits that there is no indication that Sakaguchi even *contemplates* a method in which redirecting comprises placing a copy of the email message at a location *not dedicated* to storage of just one particular user's email and storing *only one copy* of the email message. Sakaguchi appears to store messages at one of two locations, both of which *are dedicated* to storage of just one particular user's email. Therefore, Sakaguchi stores *multiple copies* of an e-mail message if the message is addressed to multiple recipients. For at least this reason, claim 63 is allowable.

In addition, with respect to those claims that are rejected in further view of Stockwell '942 those references are not seen to add anything of significance given the allowability of claim 53.

Claims 64-70

Claim 64 recites an email filtering method comprising [emphasis added]:

- receiving an email message at an email server that maintains inboxes for individual recipients;
- calculating a score for the email message at the server location based upon at least one of (a) the size of the email message, and (b) the number of specified recipient addresses;
- comparing the score with a threshold value that defines a likelihood of whether an email message constitutes an unwanted email message;
- responsive to the email message exceeding the threshold value, *placing a copy of the email message at a first location other than an individual storage location dedicated to an individual intended recipient of the email message*; and
- sending a notification to the intended recipients that a copy of an email message that was intended for them has been placed at the first location.

In making out the rejection of this claim, the Office argues that the combination of Cobb, Stockwell '942, and Sakaguchi teach the recited subject matter except for placing a copy of the email message at a first location other than an individual storage location dedicated to an individual intended recipient of the email message. The Office then argues that Paul teaches the missing feature and cites to the same excerpt that was reproduced earlier.

Applicant respectfully traverses the Office's rejection. Paul in no way teaches or suggests placing a copy of the email message at a first location *other than an individual storage location dedicated to an individual intended recipient*

of the email message. In fact, Paul *teaches directly away* from Applicant's claimed subject matter by marking e-mail with one of several display codes and then forwarding the email to *each user's* terminal, an individual storage location that *is dedicated* to an individual intended recipient of the e-mail message. Accordingly, for at least this reason, this claim is allowable.

Claims 65-70 depend from claim 64 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 64, are neither disclosed nor taught by the references of record, either singly or in combination with one another.

For example, **claim 68** recites that the threshold value is based upon the *number* of invalid specified recipient addresses. Again, the Office cites Mullan, column 10, lines 37-38, as disclosing something other than simply *indicating* an invalid user address in the process of trying to route the message. Applicant respectfully submits that the Office has *mischaracterized* Mullan. Mullan does not even teach *counting* the number of invalid specified recipient addresses. Mullan simply *indicates* that a specific address is in fact invalid. This is a far cry from Applicant's use of the *number* of invalid specified recipient addresses as a basis for a *threshold value* that defines a likelihood of whether an email message constitutes an unwanted email message. For at least this reason, claim 68 is allowable. In addition, with respect to those claims that are rejected in further view of Guck those references are not seen to add anything of significance given the allowability of claim 64.

Conclusion

All of the claims are in condition for allowance and Applicant respectfully requests a Notice of Allowability be issued forthwith. If the next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: 10/31/03

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